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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,578	08/25/2003	James Edwin Funk	60081-0011	4091
29989	7590	04/22/2004	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125			MEREK, JOSEPH C	
			ART UNIT	PAPER NUMBER
			3727	
DATE MAILED: 04/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/648,578

**Applicant(s)**

FUNK, JAMES EDWIN

**Examiner**

Joseph C. Merek

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/25/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a apparatus for containing debris, classified in class 220, subclass 495.06.
- II. Claims 14 and 15, drawn to a method of containing debris, classified in class 141 , subclass 10.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially and different process. The device could be used on a housing without electrical devices and could be secured to the exterior surface of the housing. .

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John Henkhaus on 5/04/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-1.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 14 and 15 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, it has not been adequately disclosed that the device can be used without the frame. The frame secures the device to the housing. The frame is required to perform the claimed function. Moreover, the specification does state that the sheath can have the two sets of magnets but still relates this embodiment with the frame. Additionally, there specification does not disclose the function of the magnets on the proximal end of the outer sheath.

Regarding claim 2, the disclosure does not state that the magnets on the proximal end of the outer sheath are capable of securing the frame and the sheath to the housing.

Regarding claim 5, the disclosure does not state that the device has two sets of magnets on the outer sheath and one or more first magnets coupled near the proximal portion of the frame. The remaining claims are included since they stem from rejected claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, it has not been adequately disclosed that the device can be used without the frame. The frame secures the device to the housing. The frame is required to perform the claimed function. Moreover, the specification does state that the sheath can have the two sets of magnets but still relates this embodiment with the frame. Additionally, there specification does not

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disclose the function of the magnets on the proximal end of the outer sheath.

Regarding claim 2, the disclosure does not state that the magnets on the proximal end of the outer sheath are capable of securing the frame and the sheath to the housing.

Regarding claims 4 and 5, there is no antecedent basis for the respective recess or the first and second recess. Regarding claim 5, the disclosure does not state that the device has two sets of magnets on the outer sheath and one or more first magnets coupled near the proximal portion of the frame. It is not clear what is being claimed. The remaining claims are included since they stem from rejected claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Alfero-Kuronya. Regarding claim 1, see Figs. 1-4, where the bag is inside the sheath 30. 18 are the spaced magnets. One is near the distal end of the sheath and one is near the proximal end of the sheath. Regarding claim 8, the magnet housing is item 16 in Fig. 16. Regarding claim 10, the magnetic housing is plastic. The method step does not add any structure that is not in the reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa (US 5,367,278) in view of Anderson et al (US 5,871,114). Regarding claim 1, Yoshikawa teaches a non-conductive outer sheath with spaced apart magnets but does not teach the removable inner liner bag configured to container debris. Anderson et al teaches a similar device with a removable bag liner. It would have been removable bag liner of Anderson et al in the device of Yoshikawa to eliminate or reduce the spillage from the recycled containers. Regarding claim 8, see Figs. 1, 2, and 4 of Yoshikawa where the magnet housing is shown as item 2. Regarding claim 9, see Fig. 5, where 5 is the magnetic shield. Regarding claim 10, the housing is plastic. The method steps do not require any structure that is not in the combination of references. Regarding claim 11, Yoshikawa does not teach the outer sheath being tapered. Anderson et al teach that the outer structure is tapered. It would have been obvious to employ the taper of Anderson et al in the device of Yoshikawa to reduce the shipping volume of multiple containers. Regarding claim 12, official notice is taken that it is well known to make baskets or containers of leather. It would have been

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obvious to employ leather in basket of Yoshikawa to provide a more visually pleasing container.

Claims 1, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton (US 6,179,025). Regarding claim 1, Sutton as seen in Figs. 1, 3, and 8, teaches an outer sheath with magnets to secure a removable inner bag where the inner bag can be different sizes but does not teach magnets in the same sheath being near the open and closed ends as they are shown in different embodiments. It would have been obvious to employ magnets near both ends to provide a sheath capable of holding different sized bags to reduce the number of sheaths. Regarding claim 12, the outer sheath is made of leather. Regarding claim 13, the inner bag is in contact with at least one of the magnets.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton in view of Koret (US 2,875,802). Regarding claim 2, Sutton does not teach the frame coupled to the outer sheath. Sutton as seen in Fig. 8, teaches a sheath with an inner bag 16 where the outer sheath is of the type that has a mouth frame but does not specifically teach the mouth frame. Koret teaches a similar outer sheath with a mouth frame. It would have been obvious to employ the frame of Koret in the outer sheath of Sutton to provide a means to hold open and secure the outer sheath mouth closed. The magnets are secured near the proximal portion of the frame. Regarding claim 3, the magnets will be secured on opposing sides of the frame since they are secured on opposing sides of the sheath.



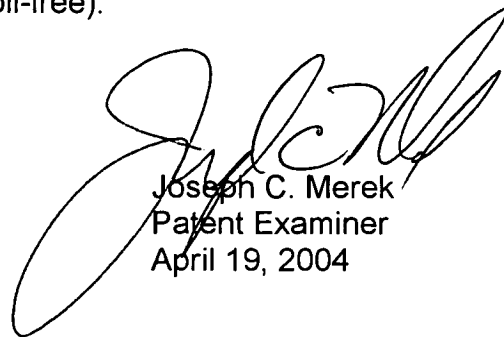
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anastos is cited for teaching a magnetically attached holder. Field is cited for teaching a bag holder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is (703) 305-0644. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merek  
Patent Examiner  
April 19, 2004